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In re Application of :
PARIS et al. :
Application No.: 09/423,109 : DECISION
Attorney Docket No.: GEI-073 :
For: HORMONAL COMPOSITION BASED ON A :
PROGESTATIONAL AGENT AND AN OESTROGEN :
AND USE THEREOF :

This decision is in response to applicants' "PETITION UNDER 37 CFR § 1.182" filed via facsimile transmission on 20 July 2004 in the United States Patent and Trademark Office (USPTO).

BACKGROUND

On 25 October 1999, applicants filed international application PCT/FR99/02588, which did not designate the United States of America.

On 29 October 1999, applicants filed a TRANSMITTAL LETTER (FORM PTO-1390) for entry into the national stage in the United States which was accompanied by, *inter alia*, the U.S. Basic National Fee, a declaration of the inventors, and a translation of the international application into English including a specification and claims.

On 12 June 2001, applicants submitted a new declaration of inventors.

On 02 August 2001, the USPTO mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating, *inter alia*, that the oath or declaration does not comply with 37 CFR 1.497(a)-(b) because it failed to identify the application to which it was directed.

On 08 August 2001, applicants submitted a response to the Notification of Missing Requirements mailed 02 August 2001 urging that the declaration filed 12 June 2001 did correctly identify the application to which it was directed.

On 26 October 2001, a decision was mailed vacating the Notification of Missing Requirements mailed 02 August 2001 and indicating that while the declaration filed 29 October 1999 failed to correctly identify the application, the declaration filed 12 June 2001 did correctly

identify the application.

On 16 November 2001, a NOTIFICATION OF ACCEPTANCE OF APPLICATION UNDER 35 U.S.C. 371 (Form PCT/DO/EO/903) was mailed indicating that the application was accepted under 35 U.S.C. § 371.

On 20 July 2004, applicants filed the instant "PETITION UNDER 37 CFR § 1.182" via facsimile transmission. The petition requests that the application be converted from an application filed under 35 U.S.C. 371 to an application filed under 35 U.S.C. 111(a).

DISCUSSION

Because the international application failed to designate the United States, applicant is not entitled to rely on the papers filed 29 October 1999 to enter the national stage in the United States. The transmittal letter of 29 October 1999 was clearly an application for a United States patent. Applicant erred in identifying the application as a national stage application. The application papers contained all the elements necessary to obtain a filing date under 35 U.S.C. 111(a) and 37 CFR 1.53(b). Since applicant cannot proceed under 35 U.S.C. 371 and applicant has filed the necessary papers under 35 U.S.C. 111(a), it is appropriate in this instance to grant applicants' petition to accept the papers filed on 29 October 1999 as an application filed under 35 U.S.C. 111(a).

Applicant is reminded that in order to perfect the claim for priority under 35 U.S.C. 119, applicant must submit certified copies of the priority documents.

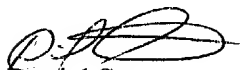
CONCLUSION

For the reasons set forth above, the petition under 37 CFR 1.182 is **GRANTED**.

The NOTIFICATION OF ACCEPTANCE OF APPLICATION UNDER 35 U.S.C. 371 mailed 16 November 2001 is hereby **VACATED**.

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

This application will be forwarded to the Office of Initial Patent Examining for processing as an application under 35 U.S.C. 111(a) having a filing date of **29 October 1999**.


Daniel Stemmer
Legal Examiner
PCT Legal Affairs

Application No.: 09/423,109

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